

REMARKS

Applicants have received and carefully reviewed the Office Action mailed January 3, 2003, in the above numbered matter. After an election, claims 1-53 remain pending. The Examiner has acknowledged that independent claims 1 and 29 are generic over dependent claims 2-28 and 30-52, respectively. Claims 1-7, 9, 11, 13-16, 18, 19, 29-35, 37-40, 42, 43 and 53 stand rejected, with the other pending claims subject to restriction if no generic claim is allowed. Applicants have amended informalities in the specification. Applicants respectfully request reconsideration and reexamination in light of the following remarks.

Applicants thank the Examiner for initialing and returning several of the PTO 1449 Forms. However, Applicants note that one Form 1449 is missing, the form having been submitted with an Information Disclosure Statement received by the OIPE at the PTO on January 8, 2002, as evidenced by return postcard. The missing Form 1449 includes three references, U.S. Patents Nos. 6,191,860 to Klinger et al., 6,192,261 to Gratton et al., and 6,236,047 to Malin et al. Applicants request that a copy of the lacking Form 1449 be initialed and returned or that the Examiner provide a brief explanation of any deficiencies with any further action.

On page 3 of the Office Action, the Examiner rejected claims 1-7, 9, 11, 13-16, 18, 19, 29-35, 37-40, 42, 43 and 53 under 35 U.S.C. §103(a) as being unpatentable over Ando et al., U.S. Patent No. 5,422,483, in view of Nobuya, Japanese Patent Publication No. 2001021489. After careful review of the cited reference, Applicants respectfully disagree.

In particular, Applicants note that the Examiner states that Ando et al. disclose "an optical filter (4) positioned to receive light from said light source, said optical filter comprising a circular variable filter (a linear variable filter being an obvious, well-known alternative to same)." However, instead of an optical filter as element 4, Ando actually discloses the following:

On the side of the integrating sphere 6 from which light is made incident, there is disposed a dark vane 4 for intermittently shutting off the measuring light 18. The dark vane 4, for example, may be fan-shaped as shown in FIG. 3 and is controlled so as to be oscillated or rotated by a motor 5 as shown by an arrow, coupled with the analyzer's measuring operation. The measuring light 18 may be thereby screened, for example, such that the dark resistance or the dark current of the detector can be adjusted in the meantime.

Column 4, lines 51-60. Applicants believe that one of skill in the art would not consider a dark vane used to assist in measuring dark current or dark resistance of the photodetectors to be a "filter." Applicants submit that one of skill in the art would consider the dark vane a shutter, not a filter having a plurality of bandpass regions as recited in claim 1. Indeed, the dark vane would function for the purposes of Ando et al. by having alternating spatially distributed areas that are entirely opaque or entirely transparent. The inclusion of a number of bandpass regions would imply that the dark vane would allow certain bands to pass, interfering with any measurement of dark current or dark resistance.

Therefore, Ando et al. fail to suggest the filter as recited in claim 1. Furthermore, modification of the dark vane to meet the recitations of claim 1 would change the principles of operation of the device and render it undesirable for the purpose given the dark vane by Ando et al. by interfering with the desired noise floor measurement (the dark noise indicated by either dark resistance or dark current, depending on the type of photodetectors and/or driving electronics used). As such, Applicants submit there would be no motivation to modify the device of Ando et al. as would be required by the Examiner's construction of the reference.

The impermissible modification of the dark vane of Ando et al. exists regardless of the teachings of the secondary reference. Therefore, Applicants believe that claim 1 is clearly patentable over the cited combination at least because the modifications of Ando et al. that are required are impermissible.

On page 2 of the Office Action the Examiner acknowledged that independent claim 1 is generic. In light of the above remarks and the Examiner's acknowledgement, Applicants believe that dependent claims 2-28 are allowable as well. Further, it is believed the dependent claims include additional elements that distinguish the cited art.

Independent claim 29 recites a spectrometer including an optical filter similar to that recited in claim 1 and, as noted above, the cited combination is impermissible at least with respect to the Examiner's suggested modification of the dark vane of Ando et al. Therefore, Applicants believe claim 29 is allowable over the cited combination as well. Again, on page 2 of the Office Action the Examiner acknowledged claim 29 to be generic, such that Applicants also believed that dependent claims 30-52 are allowable as well. These dependent claims also include further limitations that distinguish the cited art.

Independent claim 53 also recites a spectrometer including an optical filter similar in relevant respects to that recited in claim 1. Therefore, Applicants believe claim 53 is likewise patentable over the cited combination.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims, namely claims 1-53, are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

Date: _____

4/1/03



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